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09/877,317	06/08/2001	John J. Sie	19281-001610	9420
20350 7590 04/21/2009 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
BOUTAH, ALINA A				
ART UNIT		PAPER NUMBER		
2443				
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04/21/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/877,317

**Applicant(s)**

SIE ET AL.

**Examiner**

ALINA N. BOUTAH

**Art Unit**

2443

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-15 and 19-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-15 and 19-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

In view of the Appeal Brief filed on January 4, 2009, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Interview Summary***

On April 9, 2009, Examiner contacted Applicant in an effort to expedite the allowance of the present application. Applicant agreed that by incorporating claims 11 and 28 into the independent claims would be allowed. However, the Examiner has conducted a new and careful search of the pertinent prior art areas and presents herein an examination of the claims in view of the newly discovered prior art references. The instant office action is therefore made non-final in order that Applicant may properly respond on the record and submit any necessary amendment to the claims. Examiner apologizes for any inconvenience.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "content provider" in body of the claim. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 9, the preamble reads "a method for receiving a program by a user location that is sent from a **remote provider**." However, the body of the claim reads "determining if any of a first segment of each of a plurality of programs sent from **the content provider** are not already stored." It is unclear as to whether the content provider and the remote provider are the same. Clarification is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-11 and 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Youden et al. (US 5,606,359).

Regarding claim 9, Youden teaches a method for receiving a program by a user location that is sent from a remote provider, the method comprising steps of:

determining if any of a first segment of each of a plurality of programs sent from the content provider are not already stored (col. 3, lines 53-64 – if data is not already available on one of the disk drive arrays, the archival storage subsystem begins transcribing the video data to the plurality of disks. a predetermined fraction of the video data is stored on each disk sequentially with each disk receiving many small portions of the film. This is also called “data striping.”);

recording any first segment of each of the plurality of programs that are not already stored, wherein determining if any first segment of the plurality of programs are not already stored and recording any first segment that is not already stored are performed before any user request for any of the plurality of programs (col. 10, lines 52-54 - “the first five minutes of the two hundred most popular films can be “pre-striped” to one or more disk arrays. A request for one of these films would be serviced quickly with the pre-striped video data, while the remainder of the video data program is recalled from archival storage and transcribed to the disk array”);

detecting the user request for one of the plurality of programs (col. 10, lines 36-37 – “a user, through his or her STB makes a request which is transmitted over one of the communication channels in distribution network); and

recording a second segment of the one of the plurality of programs in response to the detecting step (col. 10, lines 62-65 – “once real time controller receives a

command to being playing a film, it begins a prefetch to fill the appropriate buffers in data source”).

Regarding claim 10, Youden teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, further comprising a step of recording any remaining segments of the one of the plurality of programs (col. 10, lines 62-65 – “once real time controller receives a command to being playing a film, it begins a prefetch to fill the appropriate buffers in data source”).

Regarding claim 11, Youden teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first segment is sent on a first digital channel and the second segment is sent on a second digital channel (col. 10, lines 52-61 - first segment is pre-stripped while second segment is transcribed from archival storage to disk array).

Regarding claim 13, Youden teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, further comprising a step of playing the one of the plurality of programs (col. 4, lines 12-13).

Regarding claim 14, Youden teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the detecting step comprises steps of: receiving a wireless request from a remote control; and processing the wireless request to determine a desired program (col. 4, line 66 to col. 5, line 10 – IR, RF, microwave, etc).

Regarding claim 15, Youden teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first listed recording step comprises a step of recording the first segment on a mass storage device associated with a set top box that is proximate to the user location (i.e. recording onto user's STB).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 and 19-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Youden in view of Inoue et al. (US 5,729,280).

Regarding claim 12, Youden fails to explicitly teach the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first segment and the second segment are on different transponders. Inoue teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first segment and the second segment are on different transponders (figures 6A-C; the pre-recorded segments and the remaining of the segments are recorded on different channel). At the time the invention was made, one of ordinary skill in the art would have been motivated to send first and second segments on different transponders in order to allow them to be separately processed, thus ensuring that the viewing of the first segment is faster.

Regarding claim 19, Youden teaches a method for receiving a program by a user location that is sent from a content provider, the method comprising steps of:

recording a first segment of a plurality all of the programs sent from the content provider before any user request for the program (col. 10, lines 52-54 - "the first five minutes of the two hundred most popular films can be "pre-stripped" to one or more disk arrays. A request for one of these films would be serviced quickly with the pre-stripped video data, while the remainder of the video data program is recalled from archival storage and transcribed to the disk array");



detecting the user request for selected program of the plurality of programs (col. 10, lines 36-37 – “a user, through his or her STB makes a request which is transmitted over one of the communication channels in distribution network).

However, Youden fails to explicitly teach recording a second segment of the selected program if the user request is detected before a stagger period expires wherein the period is less than a duration of the program.

Inoue teaches recording a second segment of the selected program if the user request is detected before a stagger period expires wherein the period is less than a duration of the program (col. 8, lines 35-62: recording the rest of the program; figure 4A – user’s request is detected at T6 before a period (of 5 mins) is expired, channel 3 records program a3; col. 8, line 64 to col. 9, line 10).

At the time the invention was made, one of ordinary skill in the art would have been motivated to record a second segment of the selected program if the user request is detected before a stagger period expires in order to ensure that the remaining of the program is recorded, thus allowing viewer to view the entire content.

Regarding claim 20, Inoue teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 19, wherein the detecting step comprises a step of detecting the user request for the program during the step of recording the first segment (col. 8, lines 35-62).

Regarding claim 21, Inoue teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 19, wherein the recording steps comprise a step of recording on a rotating disk at the user location (col. 4, lines 36-46).

Regarding claims 22 and 25, Inoue teaches wherein the first segment of each of the plurality of programs is sent from the content provider once (figure 4A).

Regarding claims 23 and 26, Inoue teaches wherein the first segment of each of the plurality of programs are sent from the content provider on the same channel (figure 4A).

Regarding claims 24 and 27, Inoue teaches wherein the second segment of the selected program is sent from the content provider more than once and on more than one channel (figure 4A).

Regarding claims 28 and 29, Inoue teaches wherein the second channel does not send the first segment and the first digital channel does not send the second segment (figure 2A – i.e. each of the segments are being sent from different channels).

Regarding claim 30, Inoue teaches wherein the first segment is sent only once (figure 2A).

Regarding claim 31, Inoue teaches wherein the first segment is sent via a first delivery mechanism and the second segment is sent via a second delivery mechanism (i.e. broadcast system such as cable).

Regarding claim 32, Inoue teaches wherein first delivery mechanism comprises a cable television network. However, Inoue does not explicitly teach the second delivery mechanism comprising a broadband network connection. Nevertheless, one of ordinary skill in the art would recognize that is obvious since broadband is known to be one of many mechanisms that deliver videos. One of ordinary skill in the art would have been motivated to employ broadband because it is cheap, fast and reliable.

### ***Conclusion***

It is noted that the column, line, and/or page number citations used in the prior art references as applied by the Examiner to the claimed invention are for the convenience of the Applicant to represent the relevant teachings of the prior art. The prior art references may contain further teachings and/or suggestions that may further distinguish the citations applied to the claims, therefore, the Applicant should consider

the entirety of these prior art references during the process of responding to this Office Action. It is further noted that any alternative and non-preferred embodiments as taught and/or suggested within the prior art references also constitute prior art and the prior art references may be relied upon for all the teachings would have reasonably suggested to one of ordinary skill in the art. See MPEP 2123.

The prior art listed in the PT0-892 form included with this Office Action disclose methods, systems, and apparatus similar to those claimed and recited in the specification. The Examiner has cited these references to evidence the level and/or knowledge of one of ordinary skill in the art at the time the invention was made, to provide support for universal facts and the technical reasoning for the rejections made in this Office Action including the Examiner's broadest reasonable interpretation of the claims as required by MPEP 2111 and to evidence the plain meaning of any terms not defined in the specification that are interpreted by the Examiner in accordance with MPEP 2111.01. The Applicant should consider these cited references when preparing a response to this Office Action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALINA N. BOUTAH whose telephone number is (571)272-3908. The examiner can normally be reached on Monday-Friday (9:00 am - 5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia L.M. Dollinger can be reached on 571-272-4170. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alina N Boutah/  
Primary Examiner, Art Unit 2443